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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			EXAMINER NELSON, FREDA ANN	
			ART UNIT 3628	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/696,298

Applicant(s)

ZWICKER ET AL.

Examiner

FREDA A. NELSON

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 31, 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 31-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 and 31-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The amendment received on march 31, 2009 is acknowledged and entered. Claims 1, 12, 21 and 31 have been amended. Claim 30 has been canceled. Claim 39 has been added. Claims 1-29 and 31-39 are currently pending.

Response to Amendments and Arguments

1. In response to Applicant's argument that in regards to claim 1, Alfred et al, Thompson et al. nor Whiteknucklewelding.com fail to suggest an *"index product module for displaying all of available products that may be configured" and "a markup module and a price quoting module"*, the examiner respectfully disagrees. Alfred et al. discloses that the quotation may be based on at least in part on the marked-up estimated cost; and the quotation is electronically communicated to the requestor ([0010],[0016]). Alfred et al. further discloses the requested product is selected from a plurality of products stored in a database based on at least one product specification ([0011]). Furthermore, Applicant has disclosed that all products are displayed at once.
2. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., generating separate markups for each selected item) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's argument that the combination of references fails to disclose "separately specifying an amount a dealer price is to be increased for a marine product and each optional item available for the marine product based upon a specified figure, the Examiner respectfully disagrees. Alfred et al. discloses the markup is determined based on at least one of a plurality of mark-up factors wherein the plurality of mark-up factors includes quantity requested, product type, and product features ([0016]); and Takaoka et al. discloses when the article with the desired specifications is selected, or when the user makes request operation at the terminal, the vehicle manufacturer server or a dealer server calculates an estimated price when a dealer sells the article with the desired specifications by referring to a storage device, in which *estimated prices that the dealer can offer are registered in advance for respective choices*, in accordance with the desired specifications, and provides the calculated estimated price per article to the terminal (abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Alfred et al. to include the dealer price calculation system as taught by Takaoka et al. in order to provide the dealers with allowable prices in order to optimize profits by using markups since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

The rejection under 35 U.S.C. 112, 2nd paragraph is withdrawn due to Applicant's amendment.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 12-20** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

An invention, which is eligible for patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result.

4. **Claims 12-20** are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes must positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). Claims 12-20 identify neither the apparatus performing the recited steps nor any

transformation of underlying materials, and accordingly are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-29 and 31-39** are rejected under 35 U.S.C. 103(a) as being unpatentable over Alfred et al. (US PG Pub. 2003/0187808), in view of in view of Verchere (US PG Pub. 2001/0047312), still in further view of Takaoka et al. (US PG Pub. 2002/0099628), in further view of Thompson et al. (US PG Pub. 2004/0068485), and still in further view of Whiteknucklewelding.com.

As per claims 1, 12, 21 and 39, Alfred et al. disclose an index product module operating on a computer system for displaying all of the available products that may be configured by the marine product configuration and pricing system ([0010]-[0011],[0016],[0101]; FIG. 7);

a memory ([0038]);

a programmable circuit configured to execute program instructions stored in the memory, the program instructions including a plurality of modules ([0022])including:

a markup module operating for specifying the amount a dealer price is to be increased for a marine product and each optional item available for the marine product

based upon a specified figure ([0004],[0016],[0060]; FIG. 3);

a price quoting generation module operating for selecting the product and optional items to be included within a configured product, the price quoting generation module generating a customer price for the marine product, selected optional items, and a total price for the configured product using the pricing data from the markup module (FIGS. 7 and 8); and

a quote sheet module operating for generating a quote sheet document containing information describing the configured product and its generated price (FIG. 8).

Alfred et al. do not expressly disclose a system for marine product configuration and pricing system.

However, Verchere discloses a method and system for configuring products wherein the method and system may be applied to other applications, such as, furniture, aviation supplies, **marine supplies**, interior design, beauty salon and spa supplies, medical office supplies, restaurant and bar supplies, gift shops and clothing boutique, and other industries where products and services may be ordered (abstract). Verchere further discloses the administrator (or other entity) may specify the descriptive and pricing characteristics applicable to the process used to display the logo or advertisement ([0045]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Alfred et al to include the marine supply product configuration system of Verchere in order to provide a user a quote for a

customized marine product since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Alfred et al does not specifically disclose a markup module separately specifying the amount a dealer price is to be increased for a marine product and each optional item available for the marine product based upon a specified figure.

However, Takaoka et al. discloses when the article with the desired specifications is selected, or when the user makes request operation at the terminal, the vehicle manufacturer server or a dealer server calculates an estimated price when a dealer sells the article with the desired specifications by referring to a storage device, in which *estimated prices that the dealer can offer are registered in advance for respective choices*, in accordance with the desired specifications, and provides the calculated estimated price per article to the terminal (abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Alfred et al. to include the dealer price calculation system as taught by Takaoka et al. in order to provide the dealers with allowable prices in order to optimize profits by using markups since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of

ordinary skill in the art would have recognized that the results of the combination were predictable.

Alfred et al. do not expressly disclose an index product module for displaying marine products that may be configured and a markup module and a price quoting module for marine products.

Thompson et al. discloses although the preferred embodiments disclosed herein have been particularly described as applied to a configuration system and method for configuration of specific exemplary products (e.g., windows and doors), it should be readily apparent that the invention may be embodied to provide configuration and estimation functionality for any number of products, services or the like where configured, customized or assembled-to-order products/services are evaluated, selected, purchased, sold, supported, or otherwise considered (paragraph [0035],[0038]); and the portal provides the central services for its participating members, providing news, advertisements, means for communication between members. The portal also provides a member-to-member commerce channel providing product offerings, configuration tools, ordering and purchasing mechanisms. Fees can be charged for membership to the portal, advertisements viewed or displayed on the portal, or as part of any member-to-member commerce transactions ([0120]; also see claim 20). Thompson et al still further disclose this function set allows a project to be constructed by a customer and then imported by a dealer, distributor or sales representative for quote generation, final order pricing adjustment and negotiation.

Similarly, projects can be shared between dealers, sales-people and customer service personnel (0106)).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Alfred et al. to include the feature of Thompson et al. in order to provide a user a quote for a customized product since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Thompson et al. does not specifically disclose that configurations are for marine products, however, Whiteknucklewelding.com discloses that they specialize in Custom Marine products such as, T-Tops, RADAR Arches, Half Towers and Railings (see page 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Alfred et al. to include the feature of whiteknucklewelding.com in order to provide a user a quote for a customized marine product since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per claims 2-5 and 31-38, Alfred et al. do not expressly disclose wherein the index product module includes a second hyperlink corresponding to every product to be

configured, the second hyperlink presents specification data corresponding to a particular product, wherein the specification data is displayed within an HTML document; wherein the specification data is displayed within a PDF document.

Thompson et al discloses the invention enables production of a variety of outputs, one of which can be an order form as shown; and the client manufacturer can derive the format, content and design of the order form from an existing form in use, wherein the order forms can contain all codes 26 necessary to build a specified product as well as pricing and dealer/distributor information. The order form is a tabular view of the information needed to build the set of products defined by a particular project. Also included is an "electronic order form" mechanism through which comma or tab delimited ASCII files can be created and exported. These files can be imported by other applications and may be designed to meet the needs of each manufacturer ([0098]; FIG. 16).

Thompson et al. still further discloses the invention can also include an Import/Export function set which permits a project to be built on one computer and exported into a file format, which can be imported into the same application on another computer (provided the product knowledge sets are exactly the same) wherein this function set allows a project to be constructed by a customer and then imported by a dealer, distributor or sales representative for quote generation, final order pricing adjustment and negotiation. Similarly, projects can be shared between dealers, salespeople and customer service personnel ([0106]). Thompson et al. still further discloses the portal provides the central services for its participating members,

providing news, advertisements, means for communication between members, wherein the portal also provides a member-to-member commerce channel providing product offerings, configuration tools, ordering and purchasing mechanisms. Fees can be charged for membership to the portal, advertisements viewed or displayed on the portal, or as part of any member-to-member commerce transactions ([0120]). [The Examiner interprets this to mean that the system of Thompson et al. discloses hyperlinks to products and product information].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Alfred et al. to include the feature of Thompson et al. in order to provide the users with an electronic form which is generally associated with HTML pages for the purpose of displaying product information , as well as, ordering products.

Furthermore, information as to displaying specification data within an HTML document and a PDF document is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in would be performed the same regardless of where the data is displayed. Thus, this descriptive material will

not distinguish the claimed invention from the prior art in terms of patentability.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that it was old and well known to display data within an HTML and PDF document because where the data is displayed does not functionally relate to the steps in the method claimed.

As per claims 6-7, Alfred et al. disclose the system according to claim 1, wherein the price quoting generation module utilizes a markup percentage value to specify an amount a dealer price is to be increased when generating a customer price (paragraph [0060]); and wherein the price quoting generation module utilizes a margin percentage value to specify the amount a dealer price is to be increased when generating a customer price (paragraph [0060]).

As per claim 8, Alfred et al. disclose the system according to claim 1, wherein the quote sheet module generates the quote sheet document containing only customer pricing (FIG. 8).

As per claim 9, Alfred et al. disclose the system according to claim 1, wherein the quote sheet module generates the quote sheet document containing only dealer pricing (paragraphs [0054],[0071][0108]).

As per claims 10, 19, and 28, Alfred et al. disclose the system according to

claim 1, wherein the quote sheet module generates the quote sheet document containing both dealer pricing and customer pricing (paragraph [0108]).

As per claims 11, 13 and 22, Alfred et al. discloses the system wherein the quote sheet module further generates an optional item order sheet document for each optional item included within the configured product (FIG. 7); and wherein the price increase value corresponding to a group of the selected one or more selected optional items corresponds to a single group price increase value specified in a set of price increase values (FIG. 7).

As per claim 14-15 and 23-24, Alfred et al. discloses the method according to claim 13, wherein the price increase value is defined as a markup percentage value (paragraph [0060]); and wherein the price increase value is defined as a margin percentage value (paragraph [0070]).

As per claims 16 and 25, Alfred et al. discloses the method, wherein the method further comprises modifying the price increase value for at least one of the price increase value corresponding to one of the selected optional items to generate a modified individual price quote document (paragraph [0108]).

As per claims 17-18 and 26-27, Alfred et al. disclose the method the method, wherein the individualized price quote document includes the customer price (paragraph

[0108]); and wherein the individualized price quote document includes the dealer costs (paragraph [0108]).

As per claims 20 and 29, Alfred et al. disclose the method, wherein the method further comprises generating a set of ordering documents, each order document in the set of ordering documents corresponds to each of the selected optional items (FIGS. 7 and 8).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday -Wednesday and Friday, 10:00 AM -6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. A. N./
Examiner, Art Unit 3628

/JOHN W HAYES/
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